

REMARKS

Applicants are amending their claims in order to further clarify the definition of various aspects of the present invention. Specifically, Applicants are amending claims 1, 2, 5, 6, 13 and 19 to recite that the insulating film is "filled" in the groove.

In addition, Applicants are adding new claims 56 and 57 to the application. Claims 56 and 57, dependent respectively on claims 1 and 56, respectively recites that the element isolation region is an insulating region having a thickness greater than that of the first gate insulating film; and recites that the insulating film is integrally formed with an element isolation film defining a first MISFET forming region, with an etching rate of the insulating film filled in the groove being lower than that of a thermally oxidized film.

The election-of-species requirement on page 2 of the Office Action mailed November 5, 2004, is noted. In response thereto, Applicants respectfully elect the Species I, which the Examiner contends has claims 1-4 reading thereon.

As made clear in the following, Applicants respectfully make this election with traverse.

In this regard, the Examiner's attention is respectfully directed to 37 CFR § 1.146, which states, in pertinent part:

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable.

[Emphasis added.]

Clearly, the Office Action mailed November 5, 2004, is not such a "first action". Accordingly, it is respectfully submitted that the election-of-species requirement in the Office Action mailed November 5, 2004, is improper.

It is noted that the Examiner required an election-of-species in the prior Office Action mailed July 20, 2004, in Item 4 on pages 2 and 3 of this prior Office Action. If the Examiner had intended to present an election-of-species requirement as in the Office Action mailed November 5, 2004, the Examiner could have presented such requirement in the prior Office Action mailed July 20, 2004. It is respectfully submitted that the Examiner improperly shaped issues in the Office Action mailed July 20, 2004, by failing to present therein the election-of-species requirement as set forth in the Office Action mailed November 5, 2004; and, based thereon, presented incorrect circumstances for Applicants to make their decision in response to the Office Action mailed July 20, 2004. It is respectfully submitted that based upon the Office Action mailed July 20, 2004, and 37 CFR § 1.146, the Examiner should not be permitted to present a further election-of-species requirement in the Office Action mailed November 5, 2004.

In addition, it must be emphasized that species are embodiments of the invention and are not claims per se. See Manual of Patent Examining Procedure 806.04(e). It is respectfully submitted that the Examiner has improperly designated the species in Item 1 on page 2 of the Office Action mailed November 5, 2004, in merely designating claims without indicating the species. In contrast, note the designation of species in Item 4 on pages 2 and 3 of the Office Action mailed

July 20, 2004. For this reason also, it is respectfully submitted that the election-of-species requirement in the Office Action mailed November 5, 2004, is improper and it should be withdrawn.

Even if the election-of-species requirement in the Office Action mailed November 5, 2004, is maintained, it is respectfully requested that the Examiner properly set forth the various species by respectively pointing to embodiments of the present invention, which are the respective species.

In any event, Applicants respectfully elect Species I with claims 1-4; and respectfully submit that of the claims presently in the application and elected in the Office Action mailed July 20, 2004, claims 1-4 read on Species I.

The statement by the Examiner that claim 1 is a generic claim, is noted. Upon allowance of claim 1, it is respectfully submitted that all claims readable on Species I, II and III should be permitted to issue in a U.S. patent from the above-identified application.

In view of all of the foregoing, Applicants respectfully elect Species I (with claims 1-4 reading thereon) for prosecution on the merits in the above-identified application. Entry of the present amendments; and, subsequent thereto, examination of the Species I claims in the above-identified application in due course, are respectfully requested.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP

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Deposit Account No. 01-2135 (Docket No. 501.36694CV4), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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